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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,900	03/08/2007	Reiner Fischer	2400.041000/VLC/BAH	3603
26111	7590	06/22/2009	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			RODRIGUEZ-GARCIA, VALERIE	
ART UNIT	PAPER NUMBER			
	1626			
MAIL DATE	DELIVERY MODE			
06/22/2009	PAPER			

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/578,900	<b>Applicant(s)</b> FISCHER ET AL.
	<b>Examiner</b> VALERIE RODRIGUEZ-GARCIA	<b>Art Unit</b> 1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

#### Status

- 1) Responsive to communication(s) filed on 30 March 2009.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-5, 8 and 17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-5, 8 and 17 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-146/08)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date \_\_\_\_\_
- 5) Notice of Informal Patent Application  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

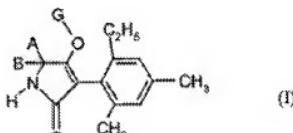
### *Status of the Claims*

Receipt of the Affidavits under 37 CFR 1.132, remarks and amendments filed on March 30, 2009 is acknowledged. Claims 6-7 and 9-16 were cancelled. Claims 1-5, 8 and 17 are pending and are the subject of this FINAL Office Action.

### *Objections*

1. The objections of claims 1-5 are withdrawn in view of applicant's amendments.
2. The Affidavits under 37 CFR 1.132 filed on March 30, 2009 disclosing "superior efficacy" of some elected compounds is not sufficient to overcome the rejection of claims 1-5, 8 and 17 under 35 U.S.C. 103(a) as being unpatentable over WO 01/74770A. The scope of the elected invention which **has overcome** the obviousness 103(a) rejection based on unexpected results provided in the Affidavits under 37 CFR 1.132 is the following:

### *The scope of the invention of the elected subject matter*



Compounds of formula I,

depicted in claim 1,

wherein: **A and B together with the carbon atom to which they are attached form a**

saturated cyclohexyl ring; G is  and R1 is alkyl, alkoxyalkyl or polyalkoxyalkyl.

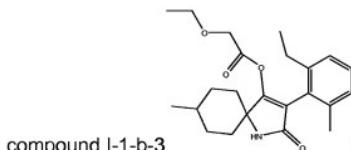
However, the full scope of the claimed invention is much broader and includes species which are different and distinct from the scope of the invention of the elected subject matter. The remaining subject matter of compounds of Formula I as claimed, which is not the scope of the invention of the elected subject matter above, contains varying functional groups which are chemically recognized to differ in structure and function from the compounds elected. Therefore the remaining subject matter differs materially in structure and composition. Thus, the evidence of unexpected results are not sufficient showing to determine similar results for the full scope of the invention as claimed which contains the different and distinct species.

In addition, the Affidavits show "superior efficacy" for the compounds of the scope of the invention above as pesticides. Claims 8 and 17 disclose a pesticide or herbicide, no showing of unexpected herbicidal activity was provided by applicants in the Affidavits received. For the above and following reasons, the rejection of claims 1-5, 8 and 17 under 35 U.S.C. 103(a) as being unpatentable over WO 01/74770A is maintained.

#### **Applicant's arguments**

Applicants argue that the Examiner is citing a 40-year old case law, that the Examiner must identify a prior art compound and provide rationale to modify it, however the Examiner did not.

Applicant's arguments have been considered but are not found persuasive. That the Examiner is citing a 40-year old case is immaterial. The Examiner identified the



compound I-1-b-3

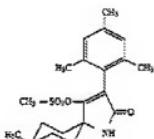
of the prior art. The prior art shows the compound was made and teaches its use as pesticide and herbicide. This is why a person of ordinary skill in the art would have selected compound I-1-b-3. The Examiner also showed that the motivation for replacing hydrogen with a methyl in exactly position Y was provided by the prior art and further substantiated by *In Re Herr* 134 USPQ 176. See previous action; the Examiner recites that Y can be H, methyl or ethyl in the generic structure shown for compounds I-1-b in the prior art. The motivation or rationale comes from the same prior art. The prior art already suggests Y being methyl. In addition, see excerpt from previous action:

Analogs differing only in the substitution of hydrogen with methyl, are *prima facie* obvious, and require no secondary teaching. However, the examiner recalls *In Re Herr* 134 USPQ 176. It would be routine for the chemist to insert a methyl group in order to increase lipophilicity. The experienced chemist, who would make applicants' compounds, would be motivated to prepare these compounds on the expectation that structurally similar compounds would possess similar properties and because it is routine nature to perform such experimentation in the art of medicinal chemistry.

3. The Affidavits under 37 CFR 1.132 filed on March 30, 2009 are not sufficient to overcome the rejection of claims 1-5 and 8 and 17 under 35 U.S.C. 103(a) as being unpatentable over Patent 5,462,913 in view of Wolff, M.E. *Burger's Medicinal Chemistry* 4<sup>th</sup> Ed. Part I, Wiley: New York, 1979, 336-337.

The compounds Applicant provides in the Affidavits are not structurally comparable to

Example (Id-1)

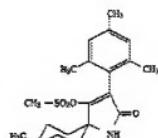


the species cited in the previous action. No conclusion can be made in regards to unexpected results and superior efficacy based on the declarations submitted. Therefore, the rejection is maintained.

#### Applicant's arguments

Applicants argue that the Examiner must identify some reason that would have led a chemist to modify a known compound in a particular manner to establish prima facie obviousness of a new claimed compound. Applicants further argue that the analysis the Examiner provides is improper because the Examiner failed to provide rationale for choosing the compound Id-1 of the prior art as lead compound, and that the statement from Wolff "that the addition of alkyl groups to pharmacological agents often improves activity", is not sufficient rationale to modify the compound.

Example (Id-1)



The Examiner identified the compound Id-1 of the prior art. The prior art shows the compound was made and teaches its use as pesticide (abstract and column 51). This is why a person of ordinary skill in the art would have selected

compound Id-1 of US 5,462,913. The Examiner also showed that the prior art compound and the instant compound are only different by a methyl, therefore are homologues. The Examiner provided further motivation in the previous action:

*Henze, 85 USPQ 261 (1950).* The instant claimed compounds would have been obvious, because one skilled in the art would have been motivated to prepare homologues of the compounds taught in the reference with the expectation of obtaining compounds which could be used in pharmaceutical compositions. However, the

The MPEP § 2144.09 states "Compounds which are homologs, differing regularly by the successive addition of the same chemical group, e.g., by -CH<sub>2</sub>- groups, are generally of sufficiently close structural similarity that there is a presumed expectation that such compounds possess similar properties. {*In re Wilder*, 563 F.2d 457, 195 USPQ 426 (CCPA 1977)}.

Similarly, the courts have recognized that *even in the case of homologs, a rejection on the basis of structural relation may be improper, with the critical question to be answered being whether the moieties of the molecules under consideration are considered 'homologous' under some available definition or whether they 'are sufficiently similar from the standpoint of structural similarity, so that those now claimed would be suggested to chemists from those disclosed and would be expected to have like properties.* (See *Ex parte Burtner and Brown*, 121 USPA 345 (1951).

Moreover, the courts have recognized that *when expectation of similar properties stands unrebutted, it necessarily follows that expectation of similar uses also stands unrebutted, [with] expectation of similar use necessarily implying expectation of substantially equivalent substitute(s).* Furthermore, *there is no logical basis for*

*distinguishing patentably between a prior art [homologous] compound and a claimed novel compound prima facie obvious therefrom, even where a previously unknown or unobvious use has been found, where that use nevertheless inheres in both compounds and it is the compound per se that is claimed.* {See *In re Hoch*, 57 CCPA 1292, 428 F.2d 1341, 166 USPQ 406 (1970)}.

Therefore, the rejection of claims 1-5 and 8 and 17 under 35 U.S.C. 103(a) as being unpatentable over Patent 5,462,913 in view of Wolff, M.E. *Burger's Medicinal Chemistry 4<sup>th</sup> Ed. Part I*, Wiley: New York, 1979, 336-337 is maintained.

4. Claims 1-5, 8 and 17 remain rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-3 of U.S. Patent No. 5,462,913 in view of Wolff, M.E. *Burger's Medicinal Chemistry 4<sup>th</sup> Ed. Part I*, Wiley: New York, 1979, 336-337.

Applicants submit the same arguments as above. The Examiner reiterates the reasoning stated above.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

**Conclusion**

Claims 1-5, 8 and 17 remain rejected. No claims are allowed.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALERIE RODRIGUEZ-GARCIA whose telephone number is (571)270-5865. The examiner can normally be reached on Monday-Friday, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kamal A Saeed/  
Primary Examiner, Art Unit 1626

VRG  
Art Unit 1626